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EXAMINER
HESSE, CAROL

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

		Application No.	Applicant(s)
		10/534,425	GOSEBRUCH ET AL.
Office Action Summary		Examiner	Art Unit	
		CAROL HESSE	2876	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>14 January 2008</u>.

2a)☒ This action is **FINAL.**   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-50</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-50</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>10 May 2005</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☒ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>14 February 2008</u>.

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

Detailed Action

Receipt is acknowledged of the amendment, filed on 14 January 2008, which has

been entered in the file. Claims 1-50 are pending.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by
another filed in the United States before the invention by the applicant for patent or (2) a patent
granted on an application for patent by another filed in the United States before the invention by the
applicant for patent, except that an international application filed under the treaty defined in section
351(a) shall have the effects for purposes of this subsection of an application filed in the United States
only if the international application designated the United States and was published under Article 21(2)
of such treaty in the English language.

1.   Claims 1-16 and 19-49 are rejected under 35 U.S.C. 102(e) as being anticipated

by Durst (Patent No.: US 7,089,420 B1).

Re claim 1, Durst teaches an article including a mark for identification of the

article, wherein the mark comprises a non-predetermined random identifier [53, 54, 60A]

comprising at least one feature peculiar to the article itself (Fig. 6, Fig. 7A-B, Fig. 9, col.

45, lines 11-63).

Re claim 19, Durst teaches a method of creating a marking for an article provided

with a mark, comprising the steps of: detecting a non-predetermined random identifier

[53, 60A, 83] comprising at least one feature peculiar to the article itself as the mark,

converting the random identifier to the marking [54, 60A with grid 200], and depositing

the marking as at least one of a data record in a data bank or a print on the article (Fig.

6-7B, Fig. 9, association by code, [56, 55, 59, 62, 63], and stored in database, col. 45,

lines 11-63, col. 46, lines 4-41).

Re claim 31, Durst teaches a method for the identification of an article provided

with a mark, the mark comprising a non-predetermined random identifier [53, 54, 60A]

that comprises at least one feature peculiar to the article itself, and wherein a marking,

which is a function of the mark, is printed on the article or filed as a data record in data

bank (Fig. 6, Fig. 7A-B, Fig. 9, col. 45, lines 11-63, col. 46, lines 32-40), the method

comprising steps of: detecting the random identifier, converting the random identifier to

an associated marking, and aligning the associated marking with the print of the

marking on the article, or the a data record of the marking filed in a data bank (Fig. 6-

7B, Fig. 9, association by code, [56, 55, 59, 62, 63], and stored in database, col. 45,

lines 11-63, col. 46, lines 4-41, and col. 31, line 25-col. 32, line 8. Further it could also

be considered that the 'alignment' pattern is the relation of the fibers [60A] to the grid

pattern [200] and stored in the database and identified and looked up by the barcode

[62, 63], Fig. 7B, col. 45, lines 31-42, col. 46, lines 32-41).

Re claim 37, Durst teaches a device for creating a marking for an article provided

with a mark, comprising: means for detecting at least one non-predetermined random

identifier comprising at least one feature peculiar to the article itself as the mark, means

for generating and displaying or outputting the marking based on the random identifier,

and means for at least one of filing or depositing the marking (random fibers forms

pattern, which in turn is imaged and converted and then stored in database in

association to another code also present on the article, col. 31, line 25- col. 32, line 8,

col. 45, lines 11-63, database, col. 46, lines 32-41).

Re claim 43, Durst teaches a device for the identification of an article including a

mark comprising a non-predetermined random identifier peculiar to the article itself, and

wherein a marking is related that is a function of the non-predetermined random

identifier, the device comprising: means for detecting (col. 43, lines 12-20) the random

identifier peculiar to the article itself, and means for generating and displaying or

outputting an associated marking based on the random identifier, wherein the

associated marking is associated with the marking created as a function of the non-

predetermined random identifier (Fig. 6-7B, Fig. 9, can be interpreted as a marking [54]

is a function of the randomly dispersed fibers [53] col. 45, line 11- col. 46, line 17, or can

be interpreted as the marking [54] is imaged to provide raster to vector conversion, the

compressed image is output and stored in a database for later comparison, col. 31,

lines 25-67).

Re claim 2, Durst teaches the article is a package (cartons, tape, Fig. 7A-B, col.

45, lines 21-42).

Re claim 3, Durst teaches the random identifier comprises a part of a design of

the article (because the random identifier exists on the article it is part of the design of

the article, col. 45, lines 11-42, also, the random identifier is in the graphic image, Fig. 9,

col. 45, lines 53-63).

Re claim 4, Durst teaches the random identifier comprises at least one random

pattern (col. 45, lines 11-63).

Re claim 5, Durst teaches the random pattern comprises a distribution of
luminophores (col. 45, lines 11-63, col. 4, lines 5-18, col. 30, lines 63-67).

Re claim 6, Durst teaches marking generated based on the random pattern and
arranged on the article (Fig. 6, Fig. 7A-B, Fig. 9, col. 45, lines 11-63).

Re claim 7, Durst teaches the distribution of luminophores is detectable and is at
least one of filed or deposited as an optionally coded marking in at least one of a data
bank or print on the package (col. 4, lines 5-18, Fig. 7A-B, col. 45, lines 11-42, col. 30,
lines 63-67).

Re claim 8, Durst teaches a code [56, 55, 59, 62, 63] applied to the article (Fig. 6,
Fig. 7A-B, col. 45, lines 11-42).

Re claim 9, Durst teaches the code includes a serial number and is in a
predetermined and reproducible relationship to the mark (Fig. 6 [52] is a numerical
representation of code [56, 55], which correspond to the random pattern, col. 45, lines
11-42).

Re claim 10, Durst teaches the code and mark are in correlation with each other
(Fig. 6 [52] is a numerical representation of code [56, 55], which correspond to the
random pattern, col. 45, lines 11-42).

Re claim 11, the correlation is formed by storage (correlation by storage of
printed code, col. 45, lines 11-30, correlation by database, col. 46, lines 32-41. The
instant application defines storage, "The storage can be formed as print on the package
10 or in an external data bank," on page 10 of the specification).

Re claim 12, Durst teaches the correlation is formed by a coding function (Fig. 6, code [56, 55] corresponds to the random pattern, col. 45, lines 11-42).

Re claim 13, Durst teaches the random identifier comprises an integral part of the article (Fig. 6, Fig. 9, or integral part of packaging, Fig. 7A-B, col. 45, lines 11-63).

Re claim 14, Durst teaches the random identifier is arranged on the whole article or in a predefined region of the article (Fig. 6, Fig. 7A-B, Fig. 9, col. 45, lines 11-63).

Re claim 15, Durst teaches the article further comprises at least one of a primary packaging, or a secondary packaging, or a tertiary packaging (Fig. 7A-B, col. 45, lines 21-42).

Re claim 16, Durst teaches at least one of the mark, the code or the marking is visibly arranged on at least one of the primary packaging, the secondary packaging, or the tertiary packaging (Fig. 7A-B, col. 45, lines 21-42).

Re claim 20, Durst teaches providing the article with a random pattern as the random identifier, the random pattern including a distribution of luminophores (col. 45, lines 11-63, col. 4, lines 5-18, col. 30, lines 63-67).

Re claims 21 and 33, Durst teaches converting stop comprises performing a suitable mathematical function (the random distribution of fibers forms a random pattern, and the pattern is imaged and converted to vector encoded data, during the authentication process a the random code is imaged and converted to appropriate vector format and an appropriate file of the ideal vector image is looked up in the database via the barcode on the document and the two are compared, col. 31, line 25-col. 32, line 8).

Re claim 22, Durst teaches the depositing step comprising coding the marking
before printing on the package or before filing in the data bank (the random identifier
pattern formed by the markings of fibers must be first deposited before the
representative image can be stored in the database, this is because the identifier is
random, so if it was stored first, than it would be a predetermined pattern, col. 31, line
25- col. 32, line 8).

Re claim 23, Durst teaches the marking is deposited in the data bank, and further
compressing the marking before filing in the data bank (col. 31, line 25- col. 32, line 8).

Re claim 24, Durst teaches the detecting step comprises optically detecting the
random identifier (col. 31, line 25- col. 32, line 8).

Re claim 25, Durst teaches numerically coding [52] the random distribution of
luminophors [54] (random distribution is associated with barcode and barcode number
representation, Fig. 6, col. 45, lines 11-20), the luminophores being visible with UV light
(col. 28, lines 14-19, col. 30-35-51), and storing the numerically coded luminophores as
the random identifier (read barcode/numerical code, col. 45, lines 11-20, look up in
database, col. 46, lines 32-41).

Re claim 26, Durst teaches providing the article with a code [56, 55, 59, 62, 63]
(Fig. 6-7B, Fig. 9, col. 45, lines 11-63).

Re claim 27, Durst teaches combining the code and the marking into a data pair,
wherein at least two of the code, the mark and the marking have a predetermined,
reproducible reference relationship to each other (random pattern [54, 60A] formed by
the distribution of random fibers is associated with barcode [55, 56, 52, 59, 62, 63] are

stored in the database, Fig. 6-7B, col. 45, lines 11-63, col. 46, lines 4-17, lines 32-41.

Further it could be considered that the combination pattern is the relation of the fibers

[60A] to the grid pattern [200] and stored in the database and identified and looked up

by the barcode [62, 63], Fig. 7B, col. 45, lines 31-42, col. 46, lines 32-41).

Re claim 28, Durst teaches correlating the marking and the code with each other

in the data pair, and filing the data pair in the data bank (random pattern [54, 60A]

formed by the distribution of random fibers is associated with barcode [55, 56, 52, 59,

62, 63] are stored in the database, Fig. 6-7B, col. 45, lines 11-63, col. 46, lines 4-17,

lines 32-41. Further it could be considered that the combination pattern is the relation of

the fibers [60A] to the grid pattern [200] and stored in the database and identified and

looked up by the barcode [62, 63], Fig. 7B, col. 45, lines 31-42, col. 46, lines 32-41).

Re claim 29, Durst teaches at least one of the code, the mark, or the marking is

applied or attached to the article either on-line or off line (encompasses all possibilities

and therefore is met by Durst, though in col. 31, lines 25-51 the storage of the reference

image appears to be on-line because it needs to be stored in the database).

Re claim 30, Durst teaches the article comprises the at least one of a primary

packaging, a secondary packaging, or a tertiary packaging; and at least one of the

code, the mark, or the marking is applied or attached to at least one of the primary

packaging, the secondary packaging, or the tertiary packaging (Fig. 7A-B, col. 45, lines

21-42).

Re claim 32, Durst teaches rendering the random identifier visible by irradiation
with light in the ultraviolet spectral range (col. 28, lines 14-19, col. 30, lines 35-51); and
optically detecting the random identifier (col. 31, line 25- col. 32, line 8).

Re claim 34, Durst teaches the detecting step comprises scanning the random
identifier to obtain identifier information (col. 45, lines 11-63), the converting step
comprises determining the associated marking from the scanned identifier information
and the aligning step comprises comparing the associated marking with the marking
(col. 46, lines 4-42, col. 31, line 25-col. 32, line 8).

Re claim 35, Durst teaches detecting a code arranged on the article (col. 45,
lines 11-63).

Re claim 36, Durst teaches forming an associated data pair comprising the
detected code and the associated marking, and comparing the associated data pair with
a data pair comprising the code and the marking previously filed in the data bank (the
random distribution of fibers forms a random pattern, and the pattern is imaged and
converted to vector encoded data, during the authentication process a the random code
is imaged and converted to appropriate vector format and an appropriate file of the ideal
vector image is looked up in the database via the barcode on the document and the two
are compared, col. 31, line 25- col. 32, line 8).

Re claim 38, Durst teaches a means for providing the article with the random
identifier (code is printed, col. 31, lines 29-33, printing process, col. 32, lines 55-67).

Re claim 39, Durst teaches the means for at least one of filing or depositing

comprises at least one of a printer or a data bank (database stores authentication data,

col. 46, lines 32-41).

Re claim 40, Durst teaches means for applying the marking to obtain the code

(apply fibers to article via printing, which together are the code, col. 31, line 25-67, or

apply code to database, col. 46, lines 32-41).

Re claim 41, Durst teaches means for coding the marking to obtain the code (the

random distribution printed forms the code, col. 45, lines 11-63, or rather, the random

distribution pattern is also converted to vector form and compressed and stored in the

database, col. 31, line 25-col. 32, line 8).

Re claim 42, Durst teaches the means for detecting, the means for generating

and displaying or outputting the marking, the means for coding and the means for at

least one of depositing or filing, are operatively linked together (Fig. 1, col. 43, lines 12-

20, further communicates with database, col. 46, lines 32-42, further, the initial forming

and storage of the representative data of the random pattern is stored for later

comparison and therefore is also connected to the database, col. 31, line 25- col. 32,

line 8).

Re claim 44, Durst teaches means for detecting is operative to emit UV light and

pick up information from the random identifier which is rendered visible (col. 28, lines

14-19, col. 30, lines 35-51, col. 31, line 25- col. 32, line 8).

Re claim 45, Durst teaches means for detecting is further operative to detect information relating to the marking [54, 60A] and a code [52, 56, 55, 59, 62, 63] located on the package (Fig. 6-7B, col. 43, lines 12-20, col. 45, lines 11-42).

Re claim 46, Durst teaches means for generating and displaying or outputting is operative to carry out a mathematical function to convert the random identifier to the associated marking (random pattern is stored in compressed form for latter use in authentication procedure, col. 31, line 25- col. 32, line 8).

Re claim 47, Durst teaches means for decoding the marking (conversion for authentication, col. 31, line 25-col. 32, line 8, imaging/scanning, col. 43, lines 12-20, col. 45, line 11- col. 46, line 41).

Re claim 48, Durst teaches means for detecting, the means for generating and displaying or outputting, and the means for decoding are coupled to a data bank (Fig. 1, col. 73, lines 12-20, detection of the random pattern and coded pattern are done via the camera and barcode reader and then the compared to the record in the database, col. 46, lines 32-41).

Re claim 49, Durst teaches means for detecting, the means for generating and displaying or outputting, the data bank, and the means for decoding are operatively linked to each other (Fig. 1, col. 43, lines 12-20, col. 46, lines 32-41).

Claim Rejections - 35 USC § 103

2.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3.   Claim 50 is rejected under 35 U.S.C. 103(a) as being unpatentable over Durst (Patent No.: US 7,089,420 B1).

        Re claim 50, Durst fails to disclose a mobile hand-held device comprising the device according to claim 43.

        However Durst teaches the barcode scanner is hand-held (Fig. 1, col. 42, lines 8-12).

        It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Durst such that the authentication system is embodied in a hand held for so that it is mobile so that it is quick and easy for an operator to use (Durst, col. 2, lines 30-45).

4.   Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Durst (Patent No.: US 7,089,420 B1) as applied to claim 16 above, and further in view of Komiya (US Patent No.: 6,155,025). The teachings of Durst are disclosed above.

        Re claim 17, Durst fails to teach the marking is arranged on the secondary packaging, the marking being designed as a link number, wherein the link number is generated from at least one of the mark, the code, or the marking arranged on the primary packaging.

        Komiya teaches a code arranged on a secondary packaging, designed as a link number, wherein the link number is in relationship to the code on the primary packaging (col. 22, lines 39-55).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Durst with Komiya for adding the ability to track the packaged items at any of the unpacking levels of the product and therefore be able to better trace the product (col. 22, lines 56-64).

5.   Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Durst (Patent No.: US 7,089,420 B1) as applied to claim 4 above, and further in view of Graphia (Derwent Publication: DE 20101554 U1).

Re claim 18, Durst fails to teach the random pattern comprises at least one of a gap width, an overlap region, a contact region of joint surfaces, a joint seam, a wave pattern of a joint seam, folds, or cut edges of the article.

Graphia teaches the random pattern comprises at least one of a gap width, an overlap region, a contact region of joint surfaces, a joint seam, a wave pattern of a joint seam, folds, or cut edges of the article (a nick is made in the joint fold so serve as a security mark [12, 15], p. 1-2).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Durst with Graphia for the benefit of providing an additional security marking that is providing on the article/package, therefore further providing a security mark that would indicated authentic products.

Response to Arguments

Applicant's arguments with respect to claims 1-50 have been considered but are moot in view of the new ground(s) of rejection. With respect to the amendments to the

independent claims making the random identifier non-predetermined, the examiner has added reference Durst; Graphia is references with respect to claim 18 because the examiner is no longer depending on Moore.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Bismarck (Publication No.: US 2001/0010332 A1) teaches code applied to multiply locations of an item and packaging, and applied at many different levels of packaging.

- Planes (FR 2763080 A1, and Derwent published abstract) teaches temperature sensitive patterns formed on the product.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to CAROL HESSE whose telephone number is (571)272-

9788. The examiner can normally be reached on Monday-Thursday 7:30-5:00, e/o

Friday 7:30-4:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Michael Lee can be reached on 571-272-2398. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

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USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/C. H./
Carol Hesse
Patent Examiner, Art Unit 2876
16 April 2008

/Michael G Lee/
Supervisory Patent Examiner, Art Unit 2876